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ABSTRACT

The collection and long-term preservation of digital content pose challenges to the intellectual property regime within which libraries and archives are accustomed to working. How to achieve an appropriate balance between copyright owners and users is a topic of ongoing debate in legal and policy circles. This paper describes copyright rights and exceptions and highlights issues potentially involved in the creation of a nonprofit digital archive. The paper is necessarily very general, since many decisions concerning the proposed archive's scope and operation have not yet been made. The purpose of an archive (e.g., to ensure preservation or to provide an easy and convenient means of access), its subject matter, and the manner in which it will acquire copies, as well as who will have access to the archive, from, where, and under what conditions, are all factors critical to determining copyright implications for works to be included in it. The goal of this pa is to provide basic information about the copyright law for those developing such an archive and thereby enable them to recognize areas in which it could impinge on copyright rights and to plan accordingly. (Author)

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Copyright Issues Relevant to the Creation of a Digital Archive:

A Preliminary Assessment

Commissioned for and sponsored by the National Digital Information Infrastructure and Preservation Program, Library of Congress

By June M. Besek

January 2003

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Copyright Issues Relevant to the Creation of a Digital Archive: A Preliminary Assessment

by June M. Besek

January 2003

Commissioned for and sponsored by the National Digital Information Infrastructure and Preservation Program, Library of Congress

Council on Library and Information Resources
Washington, D.C.
and Library of Congress

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About the National Digital Information Infrastructure and Preservation Program

The mission of the National Digital Information Infrastructure and Preservation Program is to develop a national strategy to collect, archive, and preserve the burgeoning amounts of digital content, especially materials that are created only in digital formats, for current and future generations.

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Preface

As libraries move into the digital age, they increasingly face copyright and other intellectual property questions. Creating digital surrogates and using digital technologies to make copyrighted works available to the public raise many issues. For American librarians, June Besek's essay is a most welcome tool. She has analyzed the issues that librarians must address as they are asked to make decisions about what may be made available to their patrons in digital form, and in an unbiased way she has described these issues and their implications. Additionally, she has identified areas where there is much uncertainty and recommended further studies to narrow the issues and to suggest constructive solutions.

Copyright issues are complex and can be controversial. It is a challenge to find an appropriate balance between, on one hand, serving the public interest in developing the Internet as a tool for providing information and, on the other, protecting authors' emerging digital markets. Ms. Besek makes a great contribution; she sets out concisely and clearly the breadth and depth of the issues. Authors, publishers and librarians will benefit from her insightful exploration of the possibilities and problems encountered in our digital, networked environment.

Marybeth Peters
Register of Copyrights

1. Introduction

The collection and long-term preservation of digital content pose challenges to the intellectual property regime within which libraries and archives are accustomed to working. How to achieve an appropriate balance between copyright owners and users is a topic of ongoing debate in legal and policy circles. This paper describes copyright rights and exceptions and highlights issues potentially involved in the creation of a nonprofit digital archive.[1] The paper is necessarily very general, since many decisions concerning the proposed archive's scope and operation have not yet been made. The purpose of an archive (e.g., to ensure preservation or to provide an easy and convenient means of access), its subject matter, and the manner in which it will acquire copies, as well as who will have access to the archive, from where, and under what conditions, are all factors critical to determining the copyright implications for works to be included in it.[2] The goal of this paper is to provide basic information about the copyright law for those developing such an archive and thereby enable them to recognize areas in which it could impinge on copyright rights and to plan accordingly. After initial decisions have been made, a more detailed analysis will be possible. As the paper indicates, there are a number of areas that would benefit from further research. Such research may not yield definitive legal answers, but could narrow the issues and suggest strategies for proceeding.

[1] I have assumed that the archive will be created by or in cooperation with the Library of Congress.

[2] It is my understanding that six types of works are currently contemplated for inclusion: e-books, e-journals, Web sites, digital motion pictures, digital television, and digital sound recordings. However, it appears no decision has yet been made on whether the archive will attempt to include all works in these categories or a subset of them, or on the related question whether participation will be voluntary or mandatory. Moreover, the list of six types of works may well expand as work progresses.

Background information provided to me suggested that the archive could include published and unpublished materials. For purposes of this exercise, I have assumed that those materials on publicly accessible Web sites available for downloading are published.

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2. Copyright Subject Matter

A "copyright" exists in any original work of authorship fixed in a tangible medium.[3] That medium can be almost anything, including paper, computer disk, clay, canvas, and so on. For a work to be "original," it must meet two qualifications: (1) it cannot be copied from another work; and (2) it must exhibit at least a small amount of creativity. Copyright lasts for the life of the author and 70 years thereafter.[4]

3. Copyright Rights

A copyright provides not just a single right, but a bundle of rights that can be exploited or licensed separately or together. The economic rights embraced within a copyright include the following:

The reproduction right (the right to make copies). For purposes of the reproduction right, a "copy" of a work is any form in which the work is fixed and from which it can be perceived, reproduced, or communicated, either directly or with the aid of a machine.[5] Courts have held that even the reproduction created in the short-term memory (RAM) of a computer when a program is loaded for use qualifies as a copy.[6]

The right to create adaptations, or derivative works. A "derivative work" is a work that is based on a copyrighted work, but contains new material that is original in the copyright sense. For example, the movie *Gone With the Wind* is a derivative work of the book by Margaret Mitchell. "Version" is not a term of art in copyright law. If a new version consists merely of the same work in a new form—such as a book or photograph that has been scanned to create a digital version—then it is a reproduction of the work. However, if new copyrightable authorship is added, then it is a derivative work. For example, Windows 2000 is a derivative work based on Windows 98.

The right to distribute copies of the work to the public. The distribution right is limited by the "first sale doctrine," which provides that the owner of a particular copy of a copyrighted work may sell or transfer that copy. In other words, the copyright owner, after

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[3] Copyright law is contained in Title 17 of the United States Code. All statutory references herein are to sections of Title 17, unless otherwise noted.

[4] §302(a). Certain categories of works, e.g., works first published prior to January 1, 1978 (the effective date of the current Copyright Act) and works made for hire, which are discussed below, have different terms of protection. §§304, 302(c); see also §303.

[5] §101.

[6] E.g., *MAI Systems Corp. v. Peak*, 991 F.2d 511 (9th Cir. 1993), cert. dismissed, 114 S. Ct. 671 (1994). In a recent report to Congress, the Copyright Office wrote, "Every court that has addressed the issue of reproductions in volatile RAM has expressly or impliedly found such reproductions to be copies within the scope of the reproduction right." U.S. Copyright Office, *DMCA Section 104 Report* 118 (August 2001). Available on the Copyright Office Web site at http://lcweb.loc.gov/copyright/.

the first sale of a copy, cannot control the subsequent disposition of that copy.[7] Making copies of a work available for public downloading over an electronic network qualifies as a public distribution.[8] However, neither the courts nor the Copyright Office has yet endorsed a "digital first sale doctrine" to allow users to retransmit digital copies over the Internet.[9]

The right to perform the work publicly. To "perform" a work means to recite, render, play, dance, or act it, with or without the aid of a machine.[10] Thus, a live concert is a performance of a musical composition, as is the playing of a CD on which the composition is recorded.

The right to display the work publicly. To perform or display a work "publicly" means to perform or display it anywhere that is open to the public or anywhere that a "substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered."[11] Transmitting a performance or display to such a place also makes it public. It does not matter whether members of the public receive the performance at the same time or different times, at the same place or different places. Making a work available to be received or viewed by the public over an electronic network is a public performance or display of the work.[12]

The law distinguishes between ownership of a copy of a work (even the original copy, if there is only one) and ownership of the copyright rights. A museum that acquires a painting does not thereby automatically acquire the right to reproduce it. Libraries and archives commonly receive donations of manuscripts or letters, but they generally own only the physical copies and not the copyright rights.[13]

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[7] §109(a). There are exceptions for computer programs and sound recordings, designed to deter the development of a commercial rental market.

[8] See, e.g., *Playboy Enters., Inc. v. Webbworld, Inc.*, 991 F. Supp. 543 (N.D. Texas 1997), aff'd. without opinion, 168 F.3d 486 (5th Cir. 1999); see Robert A. Gorman and Jane C. Ginsburg, *Copyright* 549-52 (New York: Foundation Press, 6th ed. 2002).

[9] In its recent *DMCA Section 104 Report*, supra note 6, the Copyright Office rejected the argument that receipt of a copy by digital transmission should be treated the same as receipt of a physical copy, with the recipient free to dispose of the digital copy at will. Digital transmission involves making a copy, not merely transferring a copy. The report expressed concern that application of the first sale doctrine would require deleting the sender's copy when it was sent to the recipient, a feature not generally available on software currently in use and unlikely to be done on a systematic basis by users. The Office also rejected the assumption that forward-and-delete is completely analogous to transferring a physical copy, because delivery and return of a digital copy can be done almost instantaneously, so fewer copies can satisfy the same demand. Id. at 96-101.

[10] §101.

[11] Id.

[12] E.g., *Kelly v. Arriba Soft Corp.*, 280 F.3d 934 (9th Cir. 2002); *Playboy Enters., Inc. v. Frena*, 839 F. Supp. 1552 (M.D. Fla. 1993).

[13] The donor frequently does not own the rights and therefore cannot convey them. For example, the writer, not the recipient, owns the copyright in letters. Even when the donor owns the rights, they are transferred to the library or archives only if the gift includes a license or assignment.

Not all rights attach to all works. For example, some works, such as sculpture, are not capable of being performed. Other works—notably musical compositions and sound recordings of musical compositions—have rights that are limited in certain respects. For example, reproduction of musical compositions in copies of sound recordings[14] is governed by a compulsory license that sets the rate at which the copyright owner must be paid.[15] Sound recordings, for historical reasons, long had no right of public performance, and they now enjoy only a limited performance right in the case of digital audio transmissions.[16]

Even though works can be converted into mere 1's and 0's when digitized, they generally retain their fundamental character. In other words, if the digitized work is a computer program, it is subject to the privilege the law provides to owners of copies of computer programs to make archival copies. If it is an unpublished work, it retains the level of protection that attaches to unpublished works, as discussed in sections 4 and 8.

4. Relevant Copyright Exceptions

Copyright rights are not absolute; they are subject to a number of limiting principles and exceptions. Those principles most relevant to the creation of a digital archive are as follows:

a. The exception for certain archival and other copying by libraries and archives in section 108 of the Copyright Act. Libraries and archives are permitted to make up to three copies of an unpublished copyrighted work "solely for purposes of preservation and security or for deposit for research use in another library or archives."[17] The work must be currently in the collections of the library or archives, and any copy made in digital format may not be made available to the public in that format outside the library premises.

Libraries and archives may also make up to three copies of a published work to replace a work in their collections that is damaged, deteriorating, or lost, or whose format has become obsolete, if the library determines that an unused replacement cannot be obtained at a fair price. Copies in digital format, like

[14] Technically, copies of sound recordings are referred to as "phonorecords" under the Copyright Act. §101.

[15] §115.

[16] §106(6), §114.

[17] §108(b). There are other conditions to the library privileges under section 108. For example, the reproduction may not be for commercial advantage; the library must be open to the public, or at least to researchers in a specialized field; and the library must include a copyright notice or legend on copies.

those of unpublished works, may not be made available to the public outside the library premises.[18]

Even if copying a work is not expressly allowed by section 108, it may still be permitted under the fair-use doctrine. However, the privileges under section 108 do not supersede any contractual obligations a library may have with respect to a work that it wishes to copy.[19]

b. Fair use is the copyright exception with which people are often most familiar. Whether a use is "fair" depends on the facts of a particular case. Four factors must be evaluated when such decisions are made. The first factor is the purpose and character of the use. Among the considerations is whether the use is for commercial or for nonprofit educational purposes. Works that transform the original by adding new creative authorship are more likely to be considered fair use than those that do not; however, even a reproduction can be considered a fair use in some circumstances. The second factor is the nature of the copyrighted work. The scope of fair use is generally broader for fact-based works than it is for fanciful works, and broader for published works than for unpublished ones.[20] The third fair use factor is the amount and substantiality of the portion used. Generally, the more that is taken, the less likely it is to be fair use, but there are situations in which making complete copies is considered fair.[21] The fourth factor is the effect on the potential market for or value of the copyrighted work. A use that supplants the market for the original is unlikely to qualify as fair.

Certain uses are favored in the statute; they include criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, and research. A nonprofit digital archive for scholarly or research use, for example, would be favored by the law. However, favored uses are not automatically deemed

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[18] §108(c). There are other privileges granted to libraries in section 108, subject to certain conditions. Libraries may reproduce articles and short excerpts at the request of users, and they may reproduce out-of-print works at users' request if those works cannot be obtained at a fair price. §108(d), (e). However, libraries may not engage in systematic reproduction and distribution of copies. Libraries may enter into interlibrary arrangements, provided the copies they receive under the arrangement do not substitute for a purchase or subscription. §108(g). Libraries and archives have broad privileges to copy and use many types of published works during the last 20 years of their copyright term for preservation and scholarship purposes, if the works are no longer being commercially exploited and cannot be obtained at a reasonable price. §108(h).

[19] §108(f)(4).

[20] Copyright law has no "public figure" exception; this is a libel law concept. Moreover, there is no special exception to permit copying of highly important or newsworthy works. As the Supreme Court stated in *Harper & Row, Pubs. v. Nation Enterprises*, 471 U.S. 539, 559 (1985): "It is fundamentally at odds with the scheme of copyright to accord lesser rights in those works that are of greatest importance to the public."

[21] For example, in *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984)—commonly referred to as the "Betamax case"—the Supreme Court held that private in-home copying of free television programs for time-shifting purposes was fair use.

fair, and other uses are not automatically deemed unfair. The four factors discussed earlier must be evaluated in each case.

Some users become frustrated because there is no magic formula to determine whether a use is fair. However, the same flexibility that sometimes makes it difficult to predict whether a use will be considered fair also allows the statute to evolve through case law with new circumstances and new types of uses. A statute that provided greater certainty would inevitably be more rigid.

c. Section 117 allows the owner of a copy of a computer program to make an archival copy of that program.[22] This section, however, applies only to computer programs, not to all works in digital form.[23]

d. As discussed in section 3, the first sale doctrine prevents the copyright owner from controlling the disposition of a particular copy of a work after the initial sale or transfer of that copy. The first sale doctrine enables, for example, library lending and marketing in used books.

5. Copyright Requirements

Those who are not specialists in the field tend to confuse two processes: registration of copyright and mandatory deposit of copyright-protected works (discussed in the next section). A copyright owner is not required to register his or her copyright or to use a copyright notice in order to establish or maintain copyright in a work. This fact is often misunderstood, particularly by people using the Internet, who sometimes assume that if there is no copyright notice, a work is in the public domain. Copyright owners are required to register their copyrights before filing an infringement suit, if the work is of U.S. origin. The law contains incentives designed to motivate copyright owners to file a timely registration; however, many copyright owners choose not to register for a variety of reasons. In any case, one should not assume that the Copyright Office has a record of all copyright-protected works.

6. Mandatory Deposit

Copyright owners are required to deposit two copies of the "best edition" of any work published in the United States with the Copyright Office. This requirement, which was enacted for the benefit of the Li-

[22] A copy or an adaptation that is an essential step in using the program in the computer is also permissible, as are copies made in the course of computer maintenance and repair. §117.

[23] In its *DMCA Section 104 Report*, supra note 6, the Copyright Office concluded that copies of digital works made in the course of periodic back-ups of computer hard drives likely qualified as fair use, but recommended a statutory change to make clear that such copies may be used exclusively for archival purposes and not for distribution. Id. at 153-61.

brary of Congress (LC), must be fulfilled within three months of the date of publication.[24] Even if the copyright owner does not register the copyright in her work, she must comply with the deposit requirement. Failure to do so does not affect the status of the copyright, but it can result in fines.[25] LC may also demand copies of specific "transmission programs," even though they are technically unpublished, or it may make a copy itself from the transmission.[26] A transmission program is "a body of material that, as an aggregate, has been produced for the sole purpose of transmission to the public in sequence and as a unit."[27]

LC is entitled to keep the deposit copies of published works for its collections or to use them "for exchange or transfer to any other library."[28] LC may also keep the deposit copies of unpublished works for its collections or may transfer them to the National Archives or a federal records center.[29] The LC's rights with respect to deposited works pertain to the physical copies, not to the underlying rights. For example, LC may not, merely by virtue of its receipt of deposit copies of motion pictures or musical works, authorize public performances of those works. The statute expressly permits the Copyright Office to make a facsimile reproduction of deposit material before transferring it to LC or otherwise disposing of it,[30] but otherwise there is no license to exercise any other rights with respect to the works. It is reasonable to interpret the law to permit LC to use deposit copies of works such as computer programs or CD-ROMs on a stand-alone computer, just as any other individual user could, even though the computer technically makes a copy when it runs or plays the work. Use on a network, by contrast, would implicate not only the reproduction right but also the rights to publicly perform, display, or distribute (depending on the work) it. Nothing in the cur-

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[24] §407. The "best edition" is the edition published in the United States that LC deems most suitable for its purposes. §101. What constitutes "publication" is considered further below and in section 8.

[25] §407(d). Certain types of works are exempt from the deposit requirement in whole or in part, either because LC is not interested in acquiring them or because the requirement imposes a hardship on the copyright owner. For example, three-dimensional sculptural works and works published only as reproduced in or on jewelry, toys, games, wall or floor coverings, or other useful articles are exempt from the deposit requirement. 37 C.F.R. §202.19 (c)(6). In the case of motion pictures, only one deposit copy is required, and LC may (and does) enter into agreements to return that copy to the depositor under certain conditions. Id. §202.19 (d)(2)(ii). Copyright owners may also request "special relief" in the event that deposit requirements pose a particular problem for them. §202.19 (e).

[26] §407(e).

[27] §101.

[28] §704(b).

[29] Id. Unpublished works are not subject to mandatory deposit (except transmission programs, as noted above), but may be deposited with the Copyright Office as part of a registration application.

[30] §704(c).

rent law would permit LC to make deposit copies generally available in digital form on a publicly accessible network.[31]

Some works—large databases, for example—are no longer distributed in complete copies in a portable medium such as a book or CD-ROM. Instead, the end users license access to the database through the Internet and generally download and print only the portion of the database relevant to their research. Whether and how the mandatory deposit provisions should be applied to works distributed in this manner, and to Web sites generally, is far from clear. For example:

- To what extent can such works be considered published, if not all of the work is available for downloading in copies?
- What if material is available to a limited group, with restrictions, and thus constitutes a "limited publication" that is technically considered unpublished under copyright law?[32]
- If materials available online are unpublished, to what extent can they be considered "transmission programs" that LC may copy or demand?[33]
- How can the deposit copy of a Web site be defined, when Web site boundaries are so amorphous?
- If the work is distributed only with technological security measures, can LC demand it in a different form?
- What is the legal effect of the license agreements that frequently accompany works available online? Can LC reasonably take the

[31] LC does put some deposit copies on a local area network pursuant to agreements with copyright owners. When LC first announced its intention to require deposits of CD-ROMs, copyright owners objected because they feared economic harm might result if their works were readily available through LC for copying and downloading. Their concern was heightened by LC's position that as the owner of the CD-ROMs pursuant to section 704(a), it was not bound by the terms of the associated license agreements. After lengthy negotiations, the parties achieved a compromise under which copyright owners could deposit a single copy under the mandatory deposit provisions or opt to enter into an agreement with LC either to (1) provide two copies of each CD-ROM for use on a stand-alone computer on LC premises (three copies if they are "copy protected"); or (2) provide one copy for use on a local area network covering LC premises and a limited number of additional locations in the Washington, D.C., area, for use by a limited number (up to five, if the copyright owner agreed) of simultaneous users. Under the agreements, which are rather complex, the copyright owner is required to provide the deposit within 60 days, rather than three months as required by §407. LC, in turn, agrees to undertake various security measures to limit downloading from or transfer of the CD-ROMs.

[32] For a discussion of the doctrine of limited publication under the 1976 Copyright Act, see 1 Melville B. Nimmer and David Nimmer, *Nimmer on Copyright* §4.13[B] (LexisNexis 2001).

[33] The provisions in the law concerning transmission programs were intended "to provide a basis for the Library of Congress to acquire, as part of the copyright deposit system, copies or recordings of non-syndicated radio and television programs without imposing any hardships on broadcasters." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 152 (1976). A transmission program is "a body of material that, as an aggregate, has been produced for the sole purpose of transmission to the public in sequence and as a unit." §101. This definition is arguably broad enough to encompass some of the materials transmitted over the Web. However, the requirement that the body of material be transmitted "in sequence and as a unit" could rule out many Web sites taken as a whole, where the user determines the materials and the sequence in which they are viewed.

position that it is not bound by them? Does it matter whether the copyright owner disseminates copies of the complete work or merely licenses the right to access it online?
- Should all works that can be downloaded from the Internet in the United States be considered "published" here for purposes of mandatory deposit? This position would substantially broaden mandatory deposit for non-U.S. works.

Even where the LC has a clear right to demand copies, it has traditionally been sensitive to copyright owners' legitimate concerns about the use of those copies, and presumably would continue to be so. This raises the following additional questions:
- Under what circumstances, and with what frequency, is it reasonable to request deposit copies of works published online?
- How can LC's needs be met without imposing serious hardship or risk on copyright owners?
- Regardless of whether LC is bound by license agreements associated with deposit copies (an issue this paper does not address), are there terms and conditions that reflect valid security or other concerns that should nevertheless be taken into account?

There are no clear answers to these questions, and little precedent. This is an area that would benefit from further study.

7. Copyright Ownership

The human creator of a work is generally the author and initial owner of copyright.[34] Copyright rights can be transferred, either separately or together. For example, someone can transfer the right to reproduce a work without transferring the right to create a derivative work. A transfer of copyright ownership, including the grant of an exclusive license, must be in writing and signed by the grantor.[35] Nonexclusive licenses need not be in writing, but frequently are.

A copyright license can span a very long period of time. Complicated issues can arise when new forms of exploitation are developed during the license term. Usually, the grantor will claim she or he did not intend to include the new rights in the license, and the grantee will claim the opposite. For example, *Random House, Inc. v. Rosetta Books LLC*[36] is an ongoing case concerning whether the words "in book form" in publishing contracts entered into before the advent of

[34] The one exception is a "work made for hire." Works made for hire are (1) works created by employees in the course of their employment, in which case the employer is deemed by law to be the author; and (2) certain types of commissioned works, provided that the parties agree in writing that the work will be a work made for hire owned by the commissioning party. §§101, 201(a), (b).

[35] §204(a).

[36] 150 F. Supp. 2d 613 (S.D.N.Y. 2001), aff'd., 2002 U.S. App. Lexis 3673 (2d Cir. Mar. 8, 2002).

electronic publishing cover electronic book rights. Contending that electronic book rights were not covered by their existing publishing agreements with Random House, the authors entered into new agreements with Rosetta to publish their books in electronic form. Recently, a federal court in New York agreed with the authors and refused to enter the preliminary injunction sought by Random House to stop Rosetta from publishing the electronic books. Decisions in these "new-use" cases usually hinge on the wording of the contract and industry practices at the time the contract was entered.[37]

Another debate about electronic rights was resolved in 2001 in *New York Times Co. v. Tasini*.[38] The Supreme Court held that *The New York Times*, in licensing back issues of the newspaper for inclusion in electronic databases such as Nexis, could not license the works of free-lance journalists contained in the newspapers. The *Times*'s contracts with the journalists did not address copyright ownership, so the newspaper relied on a provision in the Copyright Act that gives limited privileges to owners of collective works, such as journals and newspapers, in respect of individual contributions to those works.[39] According to the Court, *The New York Times* had the right to publish the free-lancers' articles in the original issue of the newspaper in which they first appeared and in revisions of that newspaper, but the authors—not the *Times*—retained the rights to license use in electronic databases. The principle announced in *Tasini* affects many other newspapers, magazines, and journals. They may not license the works of free-lance journalists for individual access through electronic databases unless they have a contract that permits them to do so.

As these two cases illustrate, ownership of electronic rights can be ambiguous, and sometimes widely dispersed.

How does one track the ownership of a copyrighted work? The process can be complicated and sometimes frustrating. The Copyright Office registration and renewal records are usually a good place to start. Registration and renewal of copyrights used to be mandatory, so registration records for older works are more likely to be complete than are those for newer works. However, even if the copyright is registered, rights may have changed hands subsequent

[37] Even though copyright law is federal law, contract disputes are decided under state law.

[38] 533 U.S. 483 (2001).

[39] Section 201(c) of the Copyright Act provides: "Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, or any later collective work in the same series."

to registration.[40] It is also possible to obtain information from the copyright notice (no longer mandatory but still commonly used) or other materials associated with the work.

Other records in the Copyright Office may be helpful. For example, the copyright law provides for recordation in the Copyright Office of transfers related to copyright.[41] To perfect a security interest in a copyrighted work or to ensure that the first transferee will prevail over a second transferee of the same interest, a license or assignment must be recorded in the Copyright Office in a timely fashion.[42] Not all copyright owners record their agreements; it is most commonly done for works of significant commercial value.

What does someone do if she wants to use a work and is unable to identify and locate the copyright owner? Some users are reluctant to use anything without clear rights, but others will engage in risk assessment. For example, if the work is to be used in a database from which it can be removed promptly if there is a complaint, the user may decide to take the risk.[43] If, by contrast, the work is a short story that is to be the basis of a new screenplay and motion picture, and the investment could be lost if the copyright owner learned of and objected to the project, the user may decide the risk is too great and choose not to proceed.

8. Unpublished Works

A work is "published" when copies are distributed to the public by sale or other transfer of ownership or by rental, lease, or lending. Publicly performing or displaying a work does not constitute publication.[44] The law makes a number of distinctions between published and unpublished works. The most significant distinction in this context relates to the treatment of published and unpublished copies for purposes of preservation under section 108 (discussed in section 4) and fair use. The scope of fair use is narrower for unpublished works than for published works, although the fact that a work is unpublished does not itself bar fair use. The unpublished nature of the manuscript of President Ford's memoirs was a significant factor in the U.S. Supreme Court's decision that *The Nation* was liable

[40] For example, the rights may be assigned or transferred by bequest or through bankruptcy. The copyright law also provides circumstances in which a contract assigning rights can be terminated and the rights reverted to the author or his or her heirs. The provisions of the law dealing with copyright transfer, including renewal, termination, and restoration, are extremely complicated and beyond the scope of this paper. However, it is important to bear in mind that when a publisher refuses to grant a license for a particular use, it may be because it does not own the necessary rights or because ownership is ambiguous.

[41] §205(a).

[42] §205(c), (d).

[43] Even if the work is removed promptly, however, the user may be liable for damages suffered by the copyright owner as a result of an infringing use.

[44] §101.

for copyright infringement in publishing excerpts of those memoirs (quotations that totaled about 300 words).[45]

9. Digital Millennium Copyright Act

The Digital Millennium Copyright Act (DMCA) prohibits the act of circumventing a technological measure that "effectively controls access" to a work protected by copyright.[46] Technological access controls are mechanisms such as passwords or encryption that prevent viewing or listening to a work without authorization.

The law also contains two provisions that prohibit trafficking in devices that circumvent technological measures of protection. The first provision is aimed at devices and services that circumvent access controls. Specifically, it prohibits manufacturing, importing, offering to the public, or providing or otherwise trafficking in technologies, products, or services

- that are primarily designed or produced to circumvent a technological measure that effectively controls access to a copyrighted work;
- that have only limited commercially significant purpose or use other than to circumvent such controls; or
- that are marketed for use in circumventing such controls.[47]

The second, similarly worded provision is a prohibition against trafficking in devices or services to circumvent rights controls.[48] Technological rights controls are mechanisms that restrict copying the work or playing it in a particular environment without authorization. *There is no prohibition on the act of circumventing rights controls.* Legislators believed if copies made as a consequence of circumventing rights controls were excused by copyright exceptions or privileges, there should be no liability for the circumvention. If, on the other hand, such copies are infringing, the rights holder has a claim under the copyright law.

There are a number of exceptions to the ban on circumventing access controls and a few exceptions to the antitrafficking ban. There is no exception for archiving, nor is there a general "fair use"-type exception written into the statute.[49] The law does, however, include an administrative procedure for creating new exceptions. Every three years the Librarian of Congress, upon the recommendation of

[45] *Harper & Row, Pubs. v. Nation Enterprises*, 471 U.S. 539 (1985).

[46] §1201(a)(1)(A).

[47] §1201(a)(2).

[48] §1201(b).

[49] There is an exception that permits a nonprofit library, archive, or educational institution to circumvent a technological access control to make a good faith determination whether to acquire a copy of the protected work. However, the institution may not retain the copy so accessed longer than necessary to make that determination, nor use it for any other purpose. §1201(d).

the Copyright Office, is directed to determine through a rule-making proceeding whether users of any particular class of copyrighted works are, or are likely to be, adversely affected in their ability to make noninfringing uses of those works by the prohibition against circumventing technological access controls. If so, the Librarian is to lift the prohibition on circumventing access controls for that particular class of works for the ensuing three-year period.[50]

The DMCA could affect archiving in a couple of ways. First, the law would prohibit an archive from circumventing technological access controls to obtain access to copyrighted works. However, should a situation arise in which that archive has legally defensible reasons for seeking to archive materials to which it has no authorized access, it could seek an exception pursuant to the rule-making procedure discussed above.

The second potential problem is the DMCA's ban on the circulation of circumvention devices. Even where a library or archive has valid access to a work, that work may be protected by a copy control. Circumventing the copy control would not violate the DMCA (its permissibility would be judged separately under the Copyright Act); however, a library or archive may not have the means readily available to make that copy because of the antitrafficking provision. It is possible that a digital archive could develop the expertise to circumvent technological controls where necessary. Moreover, it may also be possible to engage expert assistance: the law would appear to allow someone to offer circumvention services whose primary purpose and effect would be to facilitate permissible library archiving. The implications of the DMCA for archiving activities warrant further study.

10. International Issues

At least three categories of international issues must be considered in planning a digital archive. First, international treaties place certain constraints on the United States' ability to create exceptions to copyright protection or to impose requirements on copyright owners. Second, legal and logistical uncertainties could make it difficult for a copyright owner to obtain redress for copyright infringements committed abroad. These uncertainties should be considered in deciding which works should be included in the digital archive and from where they will be accessible. Third, a digital archive that permits online access outside the United States could itself be vulnerable to suit by foreign copyright owners whose works are included.

10.1 Limitations of Copyright Treaties

Through a series of copyright treaties with other countries, United States nationals have the benefit of copyright laws in many foreign

[50] §1201(a)(1)(B)-(E).

countries, and nationals of many foreign countries have the benefit of U.S. laws. The principal international copyright treaty is the Berne Convention for the Protection of Literary and Artistic Works.[51] In 1996, a new international copyright treaty was negotiated under the auspices of the World Intellectual Property Organization (WIPO). Known as the WIPO Copyright Treaty, it addresses issues raised by new technologies.[52] Many countries are amending their laws to comply with the treaty. More than 30 countries have joined.[53]

These treaties generally provide for two things: (1) national treatment, and (2) minimum standards of protection. "National treatment" means that when a U.S. citizen sues in another country—Germany, for example—he or she will be treated as a German citizen, with the benefit of German laws. Those laws will likely be similar to U.S. laws in many respects, because of the minimum standards imposed by the treaties. However, there are still likely to be differences, especially in areas related to new technologies, where international treaties and national laws sometimes have a difficult time keeping pace with technological developments.

There are many standards for copyright protection imposed on treaty members. The principal ones that could be implicated by a digital archive are the prohibition on "formalities," the limitation on exceptions to copyright rights, and the prohibition on compulsory licensing.

Article 5(2) of the Berne Convention provides that the "enjoyment and exercise" of copyright rights "shall not be subject to any formality." Prohibited formalities include such things as mandatory copyright notice or registration. Mandatory deposit is permitted, provided it is not a condition of copyright protection.

Article 9(2) of the Berne Convention provides that countries may allow for exceptions to the author's exclusive right of reproduction "in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author." The WIPO Copyright Treaty extends this limitation to all rights provided by that treaty or by the Berne Convention, not just the reproduction right.[54]

Compulsory licenses "obviously run counter to the whole basis of the [Berne] Convention, which is that the rights conferred under it are the author's exclusive rights which he can dispose of as he

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[51] The most recent version is the Paris Act, 1971. This is the version to which the United States has adhered. While the Berne Convention itself has no enforcement mechanism, the requirements of Berne were incorporated into the General Agreement on Tariffs and Trade, Agreement on Trade-Related Aspects of Intellectual Property Rights (GATT TRIPS), and are now subject to the enforcement procedures of the World Trade Organization (WTO).

[52] There is a companion treaty known as the WIPO Performances and Phonograms Treaty, or WPPT.

[53] The United States implemented the WIPO Treaties in the DMCA and has joined both treaties.

[54] WIPO Copyright Treaty, Art. 10.

wishes."[55] A compulsory license reduces the author's freedom to license (or not) to a mere right of remuneration. The Berne Convention expressly recognizes compulsory licenses only in two cases: (1) broadcasting, and (2) recordings of musical compositions.[56]

It is certainly possible to create a digital archive without violating any U.S. treaty obligations; however, such an action could not be premised on a requirement for deposit or notice linked to copyright protection. Likewise, such action could not be premised on an exception to copyright rights that would jeopardize the normal exploitation of a work, harm the author's legitimate interests, or subject works to a broad compulsory license.[57]

10.2 Potential Difficulties in Obtaining Redress for Infringements Abroad

It is assumed, for purposes of discussing this point and the next, that the archive would be located in the United States but accessible online in other countries, and that users outside the United States could download and reproduce works without authorization. Such an archive could increase copyright owners' exposure to economic harm from infringement.[58] The logistics of bringing a suit based on an infringement that takes place in another country can be daunting. First, it is difficult and costly to sue in another country. Second, as discussed above, even though national treatment is the rule, there may be significant differences among copyright laws of various nations, particularly in areas of new technology. Third, even in the unlikely case that the copyright owner were able to obtain personal jurisdiction over the defendant in the United States, a U.S. court might be reluctant to adjudicate a case involving an interpretation of a foreign country's laws.[59]

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[55] Sam Ricketson, *The Berne Convention for the Protection of Literary and Artistic Works: 1886-1986* §16.27 (Kluwer 1987).

[56] Arts. 11*bis*(2) and 13(1). It can be argued that certain limited compulsory licenses are permissible under Berne, and some countries do employ levy schemes (e.g., charges on blank tapes and equipment to compensate rights holders for home audio and videotaping). The United States has such a measure in the Audio Home Recording Act, chapter 10 of Title 17. See Ricketson, supra note 55 at §16.28. However, any compulsory license that would subject copyright owners to broad, unconsented-to use of their works could potentially violate Berne obligations.

[57] It is theoretically possible to treat U.S. and foreign works differently. Although the Berne Convention requires that a country provide these minimum standards to works of foreign nationals, a country remains free to accord its own citizens lesser rights. Berne, Art. 5(3). The United States applies differential treatment concerning copyright registration; when a lawsuit is based on a work of U.S. origin, the copyright must be registered before suit is commenced. §411(a). This is not true for a work of foreign origin, whose copyright need not be registered at all. However, differential treatment can be problematic where it is unclear when a work is of U.S. or foreign origin.

[58] Obviously, this will differ with the type of work; if the archived work is an unprotected Web site, then the copyright owner already has such exposure.

[59] Usually the law of the country where the infringement takes place is applied, but the Internet raises complex choice-of-law questions.

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Moreover, many areas remain unsettled. For example, if the archive is limited to authorized users by means of technological access controls, has a user in another country who circumvents those controls to gain access violated any law? Not all countries have laws protecting such measures from circumvention (by a ban on circumventing, on trafficking, or on both), and those that do have such laws use different approaches. Can a user in another country be held to an online agreement that restricts use of the archive? Laws on electronic contracts are still developing.

10.3 The Archive's Potential Exposure to Suits Abroad

Finally, the archive itself could be exposed to infringement suits if it were accessible outside the United States. Foreign copyright owners whose works were included in the archive might sue if their works were made accessible in countries where such use is infringing. A court outside the United States could apply the law of a country (its own or a third country) that regards placing a copyrighted work on a publicly accessible network without authorization to be an infringement.

The international issues are complicated and worthy of more detailed study.

11. Summary and Conclusion

The following paragraphs list the ways in which the archive might acquire a work and summarize the copyright and contract constraints on each approach.

Copies received through mandatory deposit. LC receives copies under the mandatory deposit provisions of the Copyright Act. Copies, including digital copies, can be made pursuant to section 108, but the circumstances under which they can be made and used are restricted, as discussed above. Placing a digital copy (whether made by LC or received in that form) on a publicly accessible network can violate a copyright owner's rights.[60] (A network accessible from only a limited number of locations can be "public" for these purposes.)

Copies obtained by gift or purchase. Copies of works that are purchased raise the same issues as do copies received through mandatory deposit. This is also true of copies received by gift, unless the gift embraces not just the physical copies but also the corresponding rights.

Copies obtained through subscription or license. Copies of works obtained through subscription or license may be subject to additional requirements of a subscription or license agreement, which may restrict use of the work beyond what the copyright law would allow.

[60] The fair-use defense may be available in some circumstances, but would have to be evaluated on a case-by-case basis.

Copies made or received under agreements with copyright owners. Some copyright owners may be willing to allow their works to be included in a digital archive. Others may agree to let their works be included if they get something in return (for example, more favorable treatment in the registration process such as "group registration"). Many copyright owners would want to ensure the existence of appropriate security measures and limitations on use, such as restrictions on where the works can be accessed, limitations on downloading, or user agreements. LC has in the past entered into agreements with copyright owners to place deposit copies on a local area network.[61]

What about copying, or "harvesting," publicly available Web sites? The law contains no specific exceptions for this type of copying, and its permissibility would likely depend on whether it qualified as fair use. That determination would have to be made on a case-by-case basis, taking into consideration such factors such as the nature of the material copied, the scope of the copying, who would have access, and how the archival use could affect the copyright owner's market. LC's ability to obtain Web site material under the mandatory deposit provisions is considered in section 6.

As this list illustrates, there is no clear road under existing law for collecting the works proposed for a digital archive and placing them on a publicly accessible network.[62] A more detailed assessment of the copyright implications of a digital archive requires further information about how the archive would operate and what it would include.

Finally, as noted throughout this paper, there are areas that would benefit from more detailed study. Additional research will not necessarily yield clear legal answers, since many of the uncertainties come from applying laws to technologies and methods of distribution they were not designed to address. Such studies could, however, narrow the issues and suggest constructive ways to achieve the goal of creating and operating an archive to ensure long-term preservation of works in digital form for the benefit of society.

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[61] See note 31, supra.

[62] This paper does not address whether or how the law could be modified to facilitate the development of a digital archive.

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